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Datasheet for the decision of 30 April 2014

Case Number: T 1483/11 - 3.2.01

Application Number: 09156222.3

Publication Number: 2067674

IPC: B60S5/04, B60C29/06, B29C73/16

Language of the proceedings: EN

Title of invention:
Kit for inflating and repairing inflatable articles, in particular tyres

Applicant:
TEK GLOBAL S.r.l.

Headword:

Relevant legal provisions:
EPC 1973 Art. 76(1), 111(1)

Keyword:
Remittal to the department of first instance - (yes)

Decisions cited:
G 0001/05, G 0001/06, T 0587/98, T 0307/03, T 1391/07, T 2402/10, T 1780/12

Catchword:

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Case Number: T 1483/11 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 30 April 2014

Appellant: (Applicant)	TEK GLOBAL S.r.l. Via Icaro 11 61100 Pesaro (IT)
Representative:	Bergadano, Mirko Studio Torta S.p.A. Via Viotti, 9 10121 Torino (IT)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 2 February 2011 refusing European patent application No. 09156222.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: G. Pricolo
Members: W. Marx
P. Guntz

Summary of Facts and Submissions

I. The appeal of the applicant (hereinafter "appellant") lies against the decision of the examining division to refuse the European patent application No. 09156222.3, published as EP 2 067 674 A1 (hereinafter "EP2A"). The present application is a divisional application of European patent application No. 05702451.5, for which patent EP 1 723 016 B1 (hereinafter "EP1B") has been granted.

II. The examining division held that EP2A did not comply with Article 76(1) EPC 1973. In a final remark, the examining division noted that a claim amended to overcome the above objection would "*contain exactly the same subject-matter as the already granted parent application*" (EP1B) and thus would not be permitted.

III. In a communication annexed to the summons to oral proceedings, the board expressed the provisional opinion that both the Main Request and the Auxiliary Request filed with the statement of grounds of appeal, filed on 13 June 2011, did not comply with the requirements of Article 76(1) EPC 1973.

IV. With letter dated 18 March 2014, the appellant filed a single request including claims 1 to 14 and withdrew all other requests. The appellant requested that the application be remitted to the examining division and oral proceedings be cancelled. As a precaution, it was requested that proceedings were continued in writing if the application was not remitted to the examining division.

V. With fax dated 19 March 2014 oral proceedings appointed for 21 March 2014 were cancelled.

VI. Claim 1 as amended according to the appellant's sole request reads as follows:

" A kit for inflating and repairing inflatable articles, in particular, tyres; the kit comprising a compressor assembly (2), a container (3) of sealing liquid, and connecting means (4, 5) for connecting the container to the compressor assembly (2) and to an inflatable article for repair or inflation, an outer casing (6) housing said compressor assembly (2) and releasable connecting means (4, 40) for stably connecting said container to said compressor assembly (2), so that the container (3), when housed in a seat (7), is maintained functionally connected to said compressor assembly (2), said kit being characterized in that said outer casing (6) is substantially parallelepiped shape and, at one longitudinal end, defines said seat (7) for housing said container (3) upside down, the seat being bounded laterally by a substantially semicylindrical end wall (10) of said outer casing (6) and at the bottom by a circular base (14) projecting from said end wall (10), said container (3) being housed removably in said seat (7)."

VII. The appellant's arguments may be summarised as follows:

Claim 1 according to the present request was amended to overcome the deficiencies under Article 76(1) EPC 1973 mentioned in the decision under appeal. Moreover, the added feature "parallelepiped shape" limited the scope of protection with respect to the patent granted in respect of the parent application.

Reasons for the Decision

1. The appeal is admissible.

2. In the decision under appeal, the examining division held that by omitting the features that "the end wall is substantially semi-cylindrical" and that "the base is circular", claim 1 represented an unallowable generalisation of the disclosure of the originally filed parent application (Article 76(1) EPC 1973). The examining division also noted that "strictly speaking", also the features "parallelepiped-shape for the casing" and "a seat at one longitudinal end" were omitted. Claim 1 according to the sole request has been amended by including, inter alia, all above-mentioned features. In particular, the seat is now defined to be bounded laterally by a "substantially semicylindrical" end wall and at the bottom by a "circular" base, as disclosed on page 5 of the parent application as originally filed, lines 16 to 19.

   Therefore, the objections raised in the decision under appeal cannot be upheld.

3. The final remark on page 7 (point 5.3) of the decision under appeal with regard to possible amendments apparently refers to the principle of prohibition of double patenting. Although this remark does not constitute a reasoned statement of the examining division in this respect, the board would like to note the following.

   The principle of prohibition of double patenting was acknowledged in Enlarged Board of Appeal decisions G 1/05 or G 1/06 (OJ EPO 2008, 271 and 307 respectively, point 13.4 of the – identical - Reasons),

referring to "*the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent*". This requirement of "same subject-matter" was followed in the established case law of the boards of appeal regarding the question of "*double patenting*" (see e.g. T 1391/07 of 7 November 2008, point 2 of the Reasons; T 2402/10 of 10 May 2012, point 8 of the Reasons; or recent T 1780/12 of 30 January 2014, points 9 and 14 of the Reasons).

In the present case, as compared to the subject-matter defined by granted claim 1 of EP1B, the subject-matter of present claim 1 has been limited by adding further technical features ("(said outer casing (6)) is substantially parallelepiped shape and, at one longitudinal end, defines said seat (7) for housing said container (3) upside down"). Moreover, such specific variant is not defined by any of the dependent claims in EP1B. This corresponds to the situation discussed in T 587/98 (OJ EPO 2000, 497, point 3.4 of the Reasons) where "*claims to A and AB in successive applications are typical of the situation prevailing when an invention is subsequently further developed by addition of a feature B*", which is not prohibited under the EPC for copending applications in an "*Article 54(3) EPC relationship*". In particular, the present case differs from the double patenting objection raised in T 307/03 (OJ EPO 2009, 422, points 3 and 5 of the Reasons), where the subject-matter of claim 1 either corresponded exactly to the subject-matter of dependent claim 3 granted on the parent application or was formulated in a broader manner.

4. Under these circumstances, and since the appellant requests remittal to the first instance, the board exercises its power pursuant to Article 111(1) EPC 1973 to remit the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first-instance for further prosecution on the basis of the request submitted with letter dated 18 March 2014.

The Registrar: The Chairman:

A. Vottner G. Pricolo

Decision electronically authenticated